UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,835	12/29/1999	GREGORY FENDIS	P06608US0/DE	2965

881 7590 02/08/2005

STITES & HARBISON PLLC
1199 NORTH FAIRFAX STREET
SUITE 900
ALEXANDRIA, VA 22314

EXAMINER	
MOSSER, ROBERT E	

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/446,835	FENDIS, GREGORY	
	Examiner	Art Unit	
	Robert Mosser	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

♦

Claims 1-43 are rejected.

Responsive to the RCE filed 12-14-2004.

♦

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 14th, 2004 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular as presently amended the claims specify that

"...each of said data input means being provided with respective locations data indicative of a respective location thereof in terms of said phases so that said respective location data is available electronically to said respective data input means...".

While the same claim further stating through amendment, that the respective location data is available "...without being provided to said respective data input means by or on behalf of a respective participant in said sport or game...".

There is an apparent disconnect between these two claim portions present in independent claims **1, 17, 30,** and **31**. Specifically it is unclear how information would exist at the data input means without being entered if only upon their initial creation and more to the point how that data is provided /made available for correlation with the input data yet at the same time considered not to be entered on behalf of the user. If a user in anyway benefits from the monitoring or utilization of data such as the storing of phase data for a respective data input means then that data serves a function on behalf of that user. For the purposes of this office action the originally presented language has been given weight and the newly presented contradiction has not been given weight.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims **1-5, 13-22, 29-38** and **41-43** are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Colley*** or ***Born*** et al in view of ***Lobb*** et al (5,810,680) in further view of **Luna** (US 5,324,028).

Regarding claims **1-5, 13-22, 29-38** and **41-43**, Colley or Born teach the limitations of the claims as discussed in the previous office actions (papers #12 and #15), incorporated herein by reference. Colley or Born are silent regarding the newly added claim features of "a participant in said sport or game can play or progress through said phases in any order without providing said location data to said respective data input means during said sport or game". Lobb teaches an input unit that has a GPS tracked input unit that has the feature of data input means is associated without being entered during said sport or game along with providing the respective location data indicative of a respective location in terms of phases of play in form of a graphical map (abstract; Fig. 1; Fig. 2 and Fig. 2A and Fig. 5A). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include these features, as taught by Lobb, in the input means of Colley or Born to make the system more convenient for the user, whereby game play does not have to be interrupted to enter pertinent data. This would increase speed of play and make gaming more enjoyable.

The combination of either Colley or Born in view of Lobb arguably fails to disclose allowing the player's to progress through the game phases in any order as now claimed. In a related application however Luna teaches and intelligent golf parties

guidance system which provides the players the ability to play the holes of a golf course out of their traditional numerical sequence (Abs). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the ability to allow golfers to play the holes of a golf course out of order as taught by Luna in the invention of Colley/Lobb or Born/Lobb so that teams would avoid delays in play due to slower teams as taught by Luna (Col 1:10-27).

Claims **6-12, 23-28** and **39-40** are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Colley*** or ***Born*** et al in view of ***Lobb*** et al (5,810,680), in further view of **Luna** (US 5,324,028) in yet further in view of ***Lyon***.

Regarding claims **6-12, 23-28** and **39-40**, Colley or Born in view of Lobb/Luna teaches all the limitations of the claims as discussed above. The references lack the explicit disclosure of the data card and reader. However, as discussed in the previous office actions (papers #12 and #15), incorporated herein by reference, Lyon teaches this feature. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the similar golf score keeping teaching of Lyon encompassed on a smart card with the golf devices of Colley, Born and Lobb/Luna to make it easier for the users to store and keep track of their scores or alternatively provide the player with a portable copy of their golf statistics.

Examiner's Response to Applicant's Remarks

Applicant's arguments filed December 14th, 2004 have been fully considered but they are not persuasive.

Applicant argues that the use of a GPS system alone could not provide location data pertinent to each phase of play prior to the commencement of play. In attempting to address this issue it has been treated separate then the first presented claim amendment due to a conflict of language. In response the applicant is first directed to figure 1 and Column 4:20-55 of Lobb wherein the Lobb discusses the correlation between a graphical representation and the golf course. This has been interpreted in view of figures 4 and 5 of Lobb where in the display of the course and correlation of the player's position to the course is determined with respect to the previously presented GPS. In view of the applicant's arguments figure 4 teaches that the information is previously stored (228) and loaded prior to game commencement thereby providing pertinent data prior to commencement of play. Further in Figure 5 of Lobb one see that information is presented to the golfer (506) prior to what could be even the first shot of the game (512). Both of these presented interpretations present a case wherein while the GPS of Lobb alone might be considered insufficient to meet the argued limitation, the graphical map system of Lobb would meet muster.

Applicant's argue that the system of Lobb would be incapable of addressing instances wherein multiple fairways might overlap or contain multiple tees. However the system of Lobb allows for the player to designate their intended target based on their location (508) this is view as similar to the use of a particular terminal in the applicant's claimed invention by a golfer.

Applicant argues that the system of Lobb would be incapable of handling the play of golf holes out of order and points to element 540 as an increment of the hole count.

While the examiner does not see an explicit teaching of this feature also referring to as passing or skipping holes in the references previously applied it none the less represents a well known practice in golf and familiar those who have played the game. However in the interests of clarity and furthering prosecution the reference of Luna has been incorporated into the standing rejection for his specific teachings regarding this subject matter. Applicant's arguments directed to whether or not the system of Lobb could function under these circumstances seem provided for in Lobb through his dependence on GPS location and player target selection. In particular the disclosure of Lobb with regards to the flow chart citation of applicant and description thereof do not limit the "hole" as described to a specific hole on the golf course verses the total number of "holes" played. As such the combination as presented is believed to address the applicant's new claim limitation and would fail to destroy any base reference in the rejection as presented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on (571)272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM

JESSICA HARRISON
PRIMARY EXAMINER